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D. REMARKS

Claims 1-5, 8-12, 15-18, and 21-48 are pending in the present application. Claims 7, 14, and 20 were cancelled; and claims 1, 3, 8, 10, 15, 17, 22-23, 25, 31, and 34-38 were amended. Reconsideration of the claims is respectfully requested.

Amendments were made to the specification to correct errors and to clarify the specification. No new matter has been added by any of the amendments to the specification.

Objection under 37 CFR § 1.75(c)

The Examiner objected to claims 14 and 20 as being in improper dependent form for failing to further limit the subject matter of the claims from which they depend. Since claims 14 and 20 are now cancelled, however, the objection has been obviated.

Non-statutory (Obviousness-type) Double Patenting

The Examiner rejected claims 1-5, 8-12, 15-18 under the judicially created doctrine of double patenting over claims 1-20 of co-pending Application Nos. 09/714,252 and 09/714,250. Applicants have abandoned both of the above-referenced Applications, thus obviating the double-patenting rejection. Applicants therefore respectfully request withdrawal of the non-statutory double patenting rejection of claims 1-5, 8-12, 15-18.

35 U.S.C. § 112, Second Paragraph

The Examiner has rejected claims 1-5, 7-12, 14-18, and 20-48 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicants regard as the invention. Claims 7, 14, and 20 being cancelled by Applicants, the rejection of claims 1-5, 8-12, 15-18, and 21-48 is respectfully traversed.

With respect to claims 21-22, 34, 36-38, and 42, the Examiner stated:

The following terms lack proper antecedent basis:

- i. the system event and the problem - claim 21;
- ii. the additional actions and the action diaries - claim 22;
- iii. the action diaries - claim 34;
- iv. the archived approaches - claims 36, 37, and 38;
- v. the archival rules - claim 38;
- vi. the approach group and the first approach group - claim 42;

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Applicants have amended claim 1, from which claim 21 depends, to include a recitation of a "system event." Thus the term "system event," as used in claim 21, now has antecedent basis in claim 1. Applicants respectfully submit that the term "problem," as used in claim 21, already had antecedent basis in claim 21 (shown in boldface below) and should not have triggered a rejection under Section 112, second paragraph.

21. (Previously presented) The method of claim 1 wherein the system event is an actual system event corresponding to a **problem** related to a network device, the method further comprising:
- searching the action diary for the system event; and
 - performing one or more actions adapted to address the problem related to the network device.

Applicants have amended claim 22 to recite "the one or more actions" (which has antecedent basis in claim 21) and "the one or more additional actions" (which has antecedent basis in claim 22), thus obviating the rejection of claim 22 under Section 112, second paragraph. Likewise, Applicants have amended claim 34 to recite "action diary" (which has antecedent basis in claim 1), rather than "action diaries," thus obviating the rejection of claim 34 under Section 112, second paragraph.

Claims 36 and 37 have been amended to recite "the one or more event solving approaches" (which has antecedent basis in claim 35) rather than "the archived approaches." In addition, claims 37 and 38 have been amended to depend from claims 36 and 35, respectively, to achieve antecedent basis for "the one or more event solving approaches" through a dependency on claim 35. Further, claim 38 has been amended to recite "the one or more archival rules" (which has antecedent basis in claim 35). Thus, the Section 112, second paragraph rejections of claims 36-38 have been obviated.

Claim 42 has been amended to recite "a first approach group," rather than simply "an approach group." This provides antecedent basis for the subsequent recitation of "the first approach group" in claim 42. Thus, the Section 112, second paragraph rejection of claim 42 has been obviated.

With respect to claim 1, the Examiner stated:

As per claim 1, lines 4-5, it is not clearly indicated from whom the second operator received the first actions (i.e., it is from the first operator or from

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the action diary when the second operator using the action diary); lines 7-9, it is uncertain what the relationship is between the first actions and the comments received and how the comments was stored in the action diary (i.e., are the comments related to the first actions and they are stored corresponding to the first action.).

Applicants have amended claim 1 to recite "receiving the first actions via the action diary by a second operator." Applicants respectfully submit that this eliminates the apparent ambiguity as to whether "using the action diary" modifies "the second operator" or "receiving." Thus, the rejection of claim 1 under Section 112, second paragraph is obviated. Claims 8 and 15 have also been similarly amended.

With respect to claims 3, 10, and 17, the Examiner stated:

As per claims 3, 10, and 17, line 3, it is not clearly indicated what "the stored actions" included (i.e., it is all the stored actions, including the first, second, and the combined actions or just the first or second or the combined actions.).

Applicants have amended claims 3, 10, and 17 to recite "the combined actions," rather than "the stored actions," thus obviating the rejection.

With respect to claims 8 and 15, the Examiner stated:

As per claim 8, lines 18-20, it is not clearly indicated that searching "a data store for the action diary" means (i.e., is it searching the received system event in the action diary.).

As per claim 15, line 13, it is not clearly indicated that searching "a data store for the action diary" means (i.e., is it searching the received system event in the action diary.).

Applicants have amended claims 1, 8, and 15 to recite "searching a data store to locate the action diary." Applicants respectfully submit that this amendment more clearly indicates that the goal of searching the data store is to locate the action diary, thus obviating the rejection.

With respect to claims 22-23, the Examiner stated:

As per claims 22 and 23, lines 3-4, it is not clearly indicated what "the actions" included (i.e., it is all the stored actions, including the first, second, and the combined actions or just the first or second or the combined actions.); lines 5-7, it is not clearly indicated what "the action diaries" means (i.e. are there many action diaries.).

Claims 22 and 23 have been amended to recite "the one or more actions," thus clearly specifying that the "actions" being described in claims 22 and 23 refer to the "one or more

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actions" recited in claim 21. In addition, claims 22 and 23 have been amended to recite "the action diary," rather than "action diaries," thus obtaining antecedent basis from claim 1.

With respect to claims 24, the Examiner stated:

As per claim 24, lines 4, it is not clearly indicated what "receiving action diary component data from the user" means.

Applicants respectfully submit that the term "action diary component data" would be clear to one of skill in the art when considered in light of the specification. The specification states that a user may create a new action diary from existing system components (see the below excerpt). These components may include documentation fields, timestamps, and other types of data. Thus, claim 24, at least when read in conjunction with the specification, is definite under the standard Section 112, second paragraph. Page 19, lines 7-25 of the specification state:

Figure 6 is a diagram of an operator creating a new action diary from existing system components. While an operator is shown in the example in Figure 6, operator involvement is not required as automated approaches may be used to create new action diaries from existing action diaries based on an incoming event or other trigger. Existing action diary 620 can be included as input for creating a new action diary (process 600). Creation of a new diary may also include system policy pre-set defaults 640. System policy pre-set defaults 640 may determine whether certain diary components, such as documentation fields, timestamps, creator, and associated link object are included in the new diary. System policy pre-set defaults 640 may also place these fields in pre-determined locations on an action diary page. Palette of objects 650 can be used by the operator to include objects such as text boxes, predefined actions, and other visual controls into the action diary page. Some visual controls, such as predefined actions, may have specific command parameters 660 that correspond with the visual control. These parameters are also included with the action diary.

With respect to claims 25 and 31, the Examiner stated:

As per claims 25 and 31, lines 3-4, it is not clearly indicated what "in response to the searching not identifying at least one action diary" means.

Applicants have amended claims 25 and 31 to instead recite "in response to the searching not resulting in an identification of at least one action diary." Applicants respectfully submit that this amended language clearly indicates that the particular step in question (capturing one or more new actions) is to be executed if the previously-recited searching did not result in the identification of at least one action diary. Applicants thus respectfully submit that the rejection of claims 25 and 31 under Section 112, second paragraph has been obviated.

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Therefore, Applicants respectfully request that the rejection of claims 1-5, 8-12, 15-18, and 21-48 under 35 U.S.C. § 112, second paragraph be withdrawn.

35 U.S.C. § 102, Anticipation

The Examiner has rejected claims 1-3 under 35 U.S.C. § 102 as being anticipated by US 6119147 (TOOMEY et al.) 2000-09-12. This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990).

Applicants have amended independent claim 1 to include features of "receiving data regarding a system event" and "searching a data store to locate the action diary, wherein the action diary corresponds to the received system event." As noted by the Examiner in the course of rejecting claim 8 (see p. 8 of the Office Action), these features are not taught by TOOMEY. Thus, TOOMEY fails to anticipate independent claim 1, as currently amended.

Since claims 2 and 3 are dependent claims that depend from claim 1, TOOMEY fails to anticipate claims 2 and 3 as well. Therefore Applicants respectfully request that the rejection of claims 1-3 under 35 U.S.C. § 102 be withdrawn.

35 U.S.C. § 103, Obviousness, Claims 7-10, 14-17, and 20-48

The Examiner has rejected claims 7-10, 14-17, and 20-48 under 35 U.S.C. § 103 as being unpatentable over US 6119147 (TOOMEY et al.) 2000-09-12 in view of US 6304861 (FERGUSON) 2001-10-16 and US 6012152 (DOUIK et al.) 2000-01-04. Claims 7, 14, and 20 being cancelled by Applicants, the rejection of claims 8-10, 15-17, and 21-48 is respectfully traversed.

With respect to independent claim 8, which is representative of the other rejected claims, the Examiner stated:

As to claim 8, it is the system claim of claim 1. See rejection for claim 1 above. Toomey also teaches the steps of a tool for coordinating operator (user interfaces and displays 120, col. 5 lines 45-55).

Toomey does not explicitly teach the steps of receiving data regarding a system event; searching a data store for the action diary, wherein the action diary corresponds to the received system event.

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Ferguson teaches the steps of receiving data (network users receive problem, col. 5 lines 25-60); searching a data in a store (searching in the notebook icon for a match proposal, col. 7 lines 25-55).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Toomey and Ferguson's system because Ferguson's searching for a problem would provide a time saving for solving the problem in the collaborative environment.

Toomey and Ferguson do not explicitly teaches the data regarding the network event.

Douik teaches the problem received regarding the network event (network faults, col. 14).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Toomey, Ferguson, and Douik's system because Douik's network event data would provide a problem solving that happens very often in the network environment.

Burden

The Office bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). The Examiner has failed to meet that burden for the following reasons.

References must teach or suggest all elements of the rejected claims

For an invention to be *prima facie* obvious, the prior art must teach or suggest all claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

With regard to independent claims 8 and 15, the references fail to teach or suggest all elements of these claims. These independent claims all recite "searching a data store to locate the action diary, wherein the action diary corresponds to the received system event." Independent claim 8, representative of the other rejected claims (including independent claim 15), is reproduced below:

8. (Currently amended) An information handling system for coordinating operator efforts, said information handling system comprising:
one or more processing units;

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a memory operatively coupled to the one or more processing units; and
a tool for coordinating operator efforts, the operator efforts coordination tool including:
 means for capturing one or more first actions taken by a first operator in
 an action diary;
 means for receiving the first actions via the action diary by a second
 operator;
 means for capturing one or more comments from at least one of the
 operators;
 means for storing the captured comments in the action diary;
 means for receiving data regarding a system event; and
 means for searching a data store to locate the action diary, wherein the
 action diary corresponds to the received system event.

The Examiner argues that FERGUSON teaches "searching a data in a store" (Office Action, p. 8), but the Examiner fails to address the claimed limitation of searching for an "action diary, wherein the action diary corresponds to the received system event." It turns out that FERGUSON does not teach searching for an action diary corresponding to a received system event. In fact, the cited portion of FERGUSON, reproduced below, does not deal with searching at all. The portion of FERGUSON relied upon by the Examiner actually describes a mechanism whereby a user may combine ideas from a group of proposals into a new, combined proposal:

FIG. 8a and b further illustrate a notebook icon 480. Notebook icon 480 enables users to store and "borrow" ideas from the other proposals the user has reviewed. When reviewing a proposal, if the user likes an idea from another proposal, the user uses a conventional pointing device, such as a mouse, to select a statement from one of the proposals, and drags the statement to notebook icon 480. When the user subsequently selects notebook icon 480, during any of the steps described herein, the list of the statements saved is returned. As also illustrated, the ranking process may have a set time limit to respond.

FIG. 9 illustrates a more detailed flow diagram of step 310 in FIG. 3. FIG. 9 includes steps 500-540.

Initially the central server notifies each user as to the user's highest ranked initial proposed solution that survived to this stage, step 500. The central server then solicits the user to update or modify that proposal, step 510.

Next, the users revise and submit updated proposals to the central server, step 520. Typically it is envisioned that users will borrow "good" ideas (statements) from other proposals the users have reviewed, and incorporate them into the proposal. Because typically more than one user will update a particular initial proposed solution, more than one updated proposal for each initial proposed solution will exist.

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FIG. 10 illustrates a display screen of a preferred embodiment of the present invention. The user may add new statements via conventional means such as a computer keyboard. Further, the user may copy ideas previously stored in notebook 550 by dragging statements onto the current proposal, and the user may throw away statements by dragging statements onto trash can 560. [col. 7, lines 26-57].

Moreover, FERGUSON is not concerned with searching for or through action diaries (that is, diaries of past actions). Rather, FERGUSON teaches a system whereby a group of users may submit, amend, and decide on proposals. FERGUSON neither teaches nor suggests any means whereby records of past actions (i.e., action diaries) may be located or consulted.

In addition, the other cited references, whether considered individually or in conjunction with FERGUSON and each other, also fail to teach or suggest this claimed feature of searching for an action diary, wherein the action diary corresponds to a received system event. As noted in Applicants' previous Response of March 12, 2004, DOUIK fails to teach or suggest an action diary of operator actions, as recited in independent claims 8 and 15. Applicants respectfully submit that DOUIK clearly also fails to teach or suggest a step of searching for such an action diary. Further, as the Examiner has already admitted, the TOOMEY reference also fails to teach or suggest this claimed feature.

No motivation to combine or modify the references to achieve the present invention exists in the prior art

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Even if the missing element of the rejected claims existed in the prior art, for the rejected claims to be obvious there must be some motivation or incentive from the prior art to modify or combine the reference teachings to achieve the present invention. The Examiner's argues that it would be obvious to one of ordinary skill in the art to combine these three references in the manner proposed, since "Ferguson's searching for a problem would provide a time saving for solving the problem in the collaborative environment" and "Dowik's network event data would provide a problem solving that happens very often in the network environment." The Examiner's argument is meaningless, however, because it presupposes that the three references

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are directed to solving related problems, when in fact they are not. While TOOMEY and FERGUSON are directed to systems that support (human) user collaboration, DOUIK is directed to a system for *automated* (non-human) fault management in a network. Moreover, neither TOOMEY nor FERGUSON are directed to fault management, but are directed to systems for virtual conferencing and proposal submission/selection, respectively. Thus, it would not be apparent to one of ordinary skill in the art to combine teachings from these references, since the technical objectives of each of these three references are entirely distinct from each other, as well as from those of the presently claimed invention.

Moreover, "[i]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." *In re Hedges*, 228 U.S.P.Q. at 687. The Examiner may not use the claimed invention as an "instruction manual" or "template" to piece together the teachings of the prior art so that the invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Such reliance is an impermissible use of hindsight with the benefit of applicant's disclosure. *Id.* In other words, unless some teaching exists in the prior art for the suggested modification, merely asserting that such a modification would be obvious to one of ordinary skill in the art is improper and cannot be used to meet the burden of establishing a *prima facie* case of obviousness. Such reliance is an impermissible use of hindsight with the benefit of Applicants' disclosure.

The present invention is directed towards a method/system for coordinating the efforts of a number of operators of a system in response to system events. Even if TOOMEY, FERGUSON, and DOUIK could be properly combined, a combination of TOOMEY, FERGUSON, and DOUIK, when made in light of what each reference fairly suggests to one of ordinary skill in the art, would not form an embodiment of the present invention as recited in independent claim 8. Instead, a combination of TOOMEY, FERGUSON, and DOUIK would result in a self-maintaining network-supported teleconferencing system with proposal submission features. It follows that the Examiner's rejection of independent claims 8 and 15 could only be grounded in an impermissible reliance on hindsight, to the exclusion of what an objective reading of the references would suggest. The rejection of claims 8 and 15 as being obvious in view of TOOMEY, FERGUSON, and DOUIK is thus improper.

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Dependent claims

If an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is non-obvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Claims 9-10, 16-17, and 21-48 are dependent claims that depend on independent claims 8 and 15. Applicants have already demonstrated claims 8 and 15 to be in condition for allowance. Applicants respectfully submit that claims 9-10, 16-17, and 21-48 are also allowable, at least by virtue of their dependency on allowable claims. Furthermore, claims 9-10, 16-17, and 21-48 recite additional subject matter not suggested by the cited reference. For instance, claim 10 recites editing stored actions, with the editing resulting a best current practice, which is neither taught nor suggested by the cited references. While FERGUSON, for example, describes a system whereby a proposed course of action may be generated through a collaborative process, neither FERGUSON nor any of the other cited references teaches editing a set of stored actions to obtain a *best current practice* (i.e., a best practice in current use).

For the foregoing reasons, Applicants submit that claims 8-10, 15-17, and 21-48 are patentable over the references. Accordingly, Applicants respectfully request that claims 8-10, 15-17, and 21-48 be allowed.

35 U.S.C. § 103, Obviousness, Claims 4-5, 11-12, and 18

The Examiner has rejected claims 4-5, 11-12, and 18 under 35 U.S.C. § 103 as being unpatentable over US 6119147 (TOOMEY et al.) 2000-09-12 in view of US 6304861 (FERGUSON) 2001-10-16, US 6012152 (DOUIK et al.) 2000-01-04, and US 6640241 (OZZIE et al.) 2003-10-28. The rejection is respectfully traversed.

Claims 4-5, 11-12, and 18 are dependent claims that depend from independent claims 1, 8, and 15 are patentable for the reasons set forth above with respect to claims 1, 8, and 15. The OZZIE reference, while it makes mention of a chat system, fails to cure the deficiencies of the other cited references with respect to the rejections of claims 1, 8, and 15. Thus, Applicants respectfully request that claims 4-5, 11-12, and 18 be allowed.

Conclusion

As a result of the foregoing, it is asserted by Applicants that the remaining claims in the Application are in condition for allowance, and Applicants respectfully request allowance of such claims.

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Applicants respectfully request that the Examiner contact the Applicants' attorney listed below if the Examiner believes that such a discussion would be helpful in resolving any remaining questions or issues related to this Application.

Respectfully submitted,

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